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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Herma GLOCKNER et al.

Application No.: 09/936,266

Filed: November 21, 2001

Group Art Unit: 1642

Examiner: K. Canella

Docket No.: 110391

For: METHOD FOR IN-VITRO TESTING OF ACTIVE SUBSTANCES, DEVICE, AND ITS USE

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RESPONSE TO RESTRICTION REQUIREMENT

Director of the U.S. Patent and Trademark Office
Washington, D. C. 20231

Sir:

In reply to the April 11, 2003 Restriction Requirement, Applicants provisionally elect claims 25-43 (Group II) with traverse.

I. Pending Claims

The Restriction Requirement indicates that only claims 1-45 are pending. However, in the Preliminary Amendment filed on September 10, 2001, claims 1-45 were amended and new claim 46 was added. The omission of claim 46 from the Restriction Requirement raises a concern as to whether the Preliminary Amendment has been properly entered.

Accordingly, for the convenience of the Patent Office, attached hereto is an additional courtesy copy of the September 10, 2001 Preliminary Amendment. If the Preliminary Amendment has not yet been entered, Applicants respectfully request entry of the Preliminary Amendment at this time.

Claim 46 is directed to a method for in-vitro testing of active substances in cells, and thus should have been included with the claims of Group I.

II. Restriction Requirement

In the Restriction Requirement, the Patent Office alleges that restriction is proper between the claims of Group I and Group II because the special technical feature, as characterized by the Patent Office, is not novel over the art.

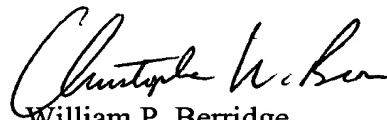
First, Applicants note that the claims of Groups I and II are of the type for which unity of invention exists. That is, as explained in MPEP 1850.C., example (B), unity of invention exists when the claims include "in addition to an independent claim for a given process, an independent claim for an apparatus or means specifically designed for carrying out the process." Thus, as the claims of Group II recite a device for carrying out the process of the claims of Group I, such claims should be permitted and examined together without restriction.

Second, the Patent Office appears to assert that in this application, unity of invention is destroyed because the device claims are anticipated by each of U.S. Patent No. 4,937,196 (Wrasidlo), DE 19810901 (Ilberg) and WO 99/28438 (Melande). However, it is at present impossible for Applicants to review such conclusion because (1) no comparison of the claim limitations and the teachings of these references was included in the Restriction Requirement so that the assertion is unsupported and therefore unreviewable, and (2) it is not clear if the assertion is based upon the proper amended claims (i.e., the claims following entry of the Preliminary Amendment) as discussed above. However, Applicants point out that during prosecution of the PCT application, claims 1-45 as set forth in the "Amended Sheets" filed with the present application were found to have novelty over the art cited during prosecution of the PCT application.

In view of the foregoing, Applicants respectfully submit that once the elected claims of Group I are examined and found in condition for allowance over the art, the Patent Office's position on unity of invention will clearly no longer be proper, and thus the method claims of Group I will ultimately need to be rejoined with the application. As such, Applicants submit that the method claims should be examined now along with the elected device claims to avoid unnecessary inefficiencies being introduced into the examination process.

For all the foregoing reasons, withdrawal of the Restriction Requirement is respectfully requested. Early and favorable action on the merits with respect to all of pending claims 1-46 is respectfully requested.

Respectfully submitted,



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Date: May 5, 2003

Attachment:

Copy of September 10, 2001 Preliminary Amendment

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